

PATENT
Attorney Docket No. 42027

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: JOHN J. WILLIAMS, JR. ET AL.

US Patent 7,627,573, issued December 1, 2009

Application No. 10/811,044, filed July 29, 2003

Confirmation No. 9536

Title: BYPASSING NATIVE STORAGE OPERATIONS BY COMMUNICATING PROTECTED DATA WITHIN LOCKING MESSAGES USING A LOCK MANAGER INDEPENDENT OF THE STORAGE MECHANISM

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT (PTA) STATED
IN THE PETITION GRANTED 05-18-2010**

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request the office reconsider its determination of the PTA.

Applicants appreciate the Office increasing Applicants PTA, but the Office apparently did not address all of Applicants concerns. Applicants respectfully request the Office increase the PTA by 23 days, as providing comments to correct a Notice of Allowance is not Applicant delay.

Applicants in the most part agree with the Office's calculation. However, Applicants respectfully dispute the reduction of the PTA by 23 days due to the Comments on Notice of Allowability filed by Applicants on August 5, 2009, to correct typographical errors in the Notice of Allowance. Such comments are not considered by the Office as a failure to engage in reasonable efforts to conclude prosecution per MPEP § 2732, page 2700-21, left column ("(6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;""). Therefore, Applicants respectfully submit that the PTA should be 957 days (which equals 934 plus 23 days). Applicants respectfully request the Office correct the PTA to be 957 days in the Certificate of Correction that the Office has stated that it intends to issue for the above-referenced issued patent.

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

The following is presented in list format to supplement the previous discussion.

- (1) Applicants have paid the fee required by 37 CFR 1.18(e) via EFS-Web contemporaneously with the submission of this paper.
- (2) Applicants believe the correct PTA is at least 957 days, and request the Office correct the determined PTA.
 - a) Applicants do not dispute the Office's determination of the PTA of 410 and 680 days due to Office delays as shown in PAIR.
 - b) Applicants do not dispute the Office's determination of reduction of the PTA by 133 days (i.e., 61+27+30+15) as shown in PAIR.
 - c) Therefore, Applicants submit that the PTA delay should be $410+680-133 = 957$.
 - d) Applicants respectfully dispute the reduction of PTA by 23 days due to the submission to correct errors in the Notice of Allowance, which is shown next to the PAIR entry: 08-05-2009 - Miscellaneous Incoming Letter.
 - e) Finally for completeness, Applicants further request, if any, additional PTA accrued pursuant to §§ 1.702(a)(4) and/or 1.702(b), or any other source.

As the prior submission did not result in the removing a reduction of PTA due to Applicants' comments on the Notice of Allowance (rather, the Office reduced the reduction from 119 days to 23 days), Applicants will more thoroughly document their position hereinafter.

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
 Request For Reinstatement Of Reduced PTA

First, below is annotated the PTA printout from PAIR illustrating the disputed delay.

BYPASSING NATIVE STORAGE OPERATIONS BY COMMUNICATING PROTECTED DATA WITHIN LOCKING MESSAGES USING A LOCK MANAGER INDEPENDENT OF THE STORAGE MECHANISM			05-28-2010::12:25:03
Patent Term Adjustments			
Patent Term Adjustment (PTA) for Application Number: 10/811,044			
Filing or 371(c) Date:	03-27-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	12-01-2009	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	934
USPTO Adjustment(days):	-	Explanation Of Calculations	
Patent Term Adjustment History			
Date	Contents Description	PTO(Days)	APPL(Days)
05-13-2010	Petition Decision - Granted		
03-15-2010	Petition Entered		
04-21-2010	Mail-Petition Decision - Granted		
04-17-2010	Petition Decision - Granted		
03-15-2010	Petition Entered		
02-05-2010	Post Issue Communication - Certificate of Correction		
12-01-2009	Recordation of Patent Grant Mailed		
11-11-2009	Issue Notification Mailed		
12-01-2009	PTA 36 Months	680	
12-01-2009	Patent Issue Date Used in PTA Calculation		
10-23-2009	Dispatch to FDC	↑	
10-23-2009	Application Is Considered Ready for Issue	↑	
10-21-2009	Issue Fee Payment Verified	↑	
10-21-2009	Issue Fee Payment Received	↑	
08-27-2009	TC Return to Pubs	↑	
08-27-2009	Mail Miscellaneous Communication to Applicant	↑	
08-26-2009	Miscellaneous Communication to Applicant - No Action Count	↑	
08-11-2009	Pubs Case Remand to TC	↑	
08-05-2009	Response to Reasons for Allowance	↑	
08-05-2009	Miscellaneous Incoming Letter	↑	23
07-24-2009	Document Verification		
07-24-2009	Notice of Allowance Data Verification Completed		
06-08-2009	Examiner Interview Summary Record (PTOL - 413)		
07-24-2009	Examiner's Amendment Communication		
06-03-2009	Date Forwarded to Examiner		
06-04-2009	Mail Appeals conf. Reopen Prosec.		
06-03-2009	Pre-Appeals Conference Decision - Reopen Prosecution		
05-18-2009	Request for Pre-Appeal Conference Filed		
05-18-2009	Notice of Appeal Filed		
05-18-2009	Request for Extension of Time - Granted		

*Simply Wrong
NOT APPLICABLE
Delay
Correcting
Notice of Allowance*

15

https://sportal.uspto.gov/secure/PA_PairPair/PAIRPrintServlet 5/28/2010

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
 Request For Reinstatement Of Reduced PTA

Next, below is annotated a image file wrapper printout showing the relevant documents.

Portions of these papers are included hereinafter for the convenience of the Office. Note, the document on 07-24-2009 is "Notice of Allowance.

BYPASSING NATIVE STORAGE OPERATIONS BY COMMUNICATING PROTECTED DATA WITHIN LOCKING MESSAGES USING A LOCK MANAGER INDEPENDENT OF THE STORAGE MECHANISM				05-28-2010::12:16:28
Mail Room Date	Document Code	Document Description	Document Category	Page Count
05-18-2010	PETDEC	Petition Decision	PROSECUTION	1
05-07-2010	PET.PTA	Patent Term Adjustment Petition	PROSECUTION	6
05-07-2010	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	2
05-07-2010	N417	EFS Acknowledgment Receipt	PROSECUTION	2
04-21-2010	PETDEC	Petition Decision	PROSECUTION	1
03-15-2010	PET.PTA.RCAL	Request for PTA recalculation in view of Wyeth	PROSECUTION	1
03-15-2010	N417	EFS Acknowledgment Receipt	PROSECUTION	2
03-09-2010	COCOUT	Certificate of Correction - Post Issue Communication	PROSECUTION	1
01-29-2010	COGIN	Request for Certificate of Correction	PROSECUTION	11
01-29-2010	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	2
01-29-2010	N417	EFS Acknowledgment Receipt	PROSECUTION	2
11-11-2009	ISSUE.NTF	Issue Notification	PROSECUTION	2
10-21-2009	IFEE	Issue Fee Payment (PTO-858)	PROSECUTION	1
10-21-2009	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1
10-21-2009	N417	EFS Acknowledgment Receipt	PROSECUTION	2
09-04-2009	CLM	Claims	PROSECUTION	3
08-27-2009	M327	Miscellaneous Communication to Applicant - No Action Count	PROSECUTION	2
08-05-2009	LET.	Miscellaneous Incoming Letter	PROSECUTION	2
07-24-2009	NOA	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION	4
07-24-2009	EXIN	Examiner Interview Summary Record (PTOL - 413)	PROSECUTION	1
07-24-2009	NOA	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION	5
07-24-2009	SRFW	Search Information including classification, databases and other search related notes	PROSECUTION	1
07-24-2009	SRNT	Examiner's search strategy and results	PROSECUTION	9
07-24-2009	SRNT	Examiner's search strategy and results	PROSECUTION	3
07-24-2009	SRNT	Examiner's search strategy and results	PROSECUTION	1
07-24-2009	BIB	Bibliographic Data Sheet	PROSECUTION	2
07-24-2009	IIFW	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION	1
07-24-2009	FWCLM	Index of Claims	PROSECUTION	1
06-04-2009	AP.PRE.DEC	Pre-Brief Appeal Conference decision	PROSECUTION	2
05-18-2009	AP.PRE.REQ	Pre-Brief Conference request	PROSECUTION	6
05-18-2009	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	2
05-18-2009	N417	EFS Acknowledgment Receipt	PROSECUTION	2
05-18-2009	N/AP	Notice of Appeal Filed	PROSECUTION	1
02-03-2009	CTFR	Final Rejection	PROSECUTION	1
02-03-2009	FWCLM	Index of Claims	PROSECUTION	20

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

Next, below is annotated a page from MPEP § 2732 stating that a request to correct a Notice of Allowance is NOT considered Applicant delay.

PATENT TERMS AND EXTENSIONS

2732

[f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(9) if the Office takes longer than four months to issue a supplemental Office action or notice of allowance. If the amendment is requested by an examiner, the examiner will have the paper processed so that it is included as part of an interview summary or examiner's amendment and not a separate paper for PALM to flag in the patent term adjustment calculation.

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application:

(1) Fees(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance of a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability"; and (7) letters related to government interests (e.g., those between NASA and the Office).

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations. 37 CFR 1.704(c)(10) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the amendment under 37 CFR 1.312 was filed and ending on the mail-

ing date of the Office action or notice in response to the amendment under 37 CFR 1.312 or such other paper; or (2) four months. The phrase "lesser of ... or [f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(10) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under 37 CFR 1.312 or other paper.

37 CFR 1.704(c)(11) establishes further prosecution via a continuing application as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Currently, a continuing application may be used to: (1) obtain further examination of an invention disclosed and claimed in the prior application (continuation application); (2) obtain examination (for the first time) of an invention disclosed but not claimed or not elected for examination in the prior application (divisional application); or (3) obtain examination of an invention neither disclosed nor claimed in the prior application (continuation-in-part application). The provisions of 35 U.S.C. 132(b) and 37 CFR 1.114 permit an applicant to obtain further or continued examination of an invention disclosed and claimed in an application, which renders it unnecessary for an applicant whose application is eligible for patent term adjustment under 35 U.S.C. 154(b) to file a continuing application to obtain further examination of an invention disclosed and claimed in an application. If an applicant is filing a continuing application to obtain examination (for the first time) of an invention disclosed but not claimed or not elected for examination in the prior application or an invention neither disclosed nor claimed in the prior application, it is not appropriate for that applicant to obtain any benefit in the continuing application for examination delays that might have occurred in the prior application. Thus, the Office has established further prosecution via a continuing application as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application, in that the period of adjustment set forth in 37 CFR 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent. Thus, if the application that resulted in the patent is a continuing application (including a CPA), the period of adjustment set forth in 37 CFR 1.703 (if any) will not

2700-21

Rev.2, May 2004

5

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

The following three pages are from the 5-page Notice of Allowance dated 07-24-2009.

Application/Control Number: 10/811,044
Art Unit: 2165

Page 2

DETAILED ACTION

1. Claims 1-26 Pending.

*Three Pages
from
Notice of Allowance*

EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kirk D. Williams on 6/8/2009.

The Claims file 11/08/2008 have been amended as follows:

a) In Line 10 of Claim 1, after "protected data" delete '.' and insert --received in a corresponding release of the lock message from a previous holder of the lock of the plurality of requestors--

a) In Line 10 of Claim 1, after "A" insert --tangible--

b) In Line 1 of Claim 8, after "medium" delete 'tangibly'

c) In Line 1 of Claim 8, after "protected data" delete '.' and insert --received in a corresponding release of the lock message from a previous holder of the lock of the plurality of requestors--

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

Application/Control Number: 10/811,044
Art Unit: 2165

Page 3

- d) In Line 10 of Claim 12, after "message," delete 'and'
- e) In Line 12 of Claim 12, after "protected data" delete '' and insert --; and sending a second grant message to the second requestor, the second grant message including said protected data received in the first release message.--
- f) In Line 1 of Claim 13, after "claim 12," delete 'comprising sending a second grant message to the second requester' and insert --wherein--
- g) In Line 2 of Claim 13, after "second grant message" delete 'including said protected data, and' and insert --includes--
- h) In Line 1 of Claim 17, after "A" insert --tangible--
- i) In Line 1 of Claim 17, after "medium" delete 'tangibly'
- j) In Line 11 of Claim 17, after "message," delete 'and'
- k) In Line 13 of Claim 17, after "protected data" insert --; and sending a second grant message to the second requester, the second grant message including said protected data received in the first release message--

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

Application/Control Number: 10/811,044
Art Unit: 2165

Page 4

- i) In Line 1 of Claim 18, after "wherein" delete 'said steps comprise sending a second grant message to the second requester,'
- m) In Line 13 of Claim 18, after "message" delete 'including said protected data, and' and insert --includes--
- n) In Line 9 of Claim 22, after "message;" delete 'and'
- o) In Line 11 of Claim 22, after "protected data" insert --; and means for sending a second grant message to the second requester, the second grant message including said protected data received in the first release message--
- p) In Line 1 of Claim 23, after "claim 22," delete 'comprising means for sending a second grant message to the second requester,' and insert --wherein--
- p) In Line 103 of Claim 23, after "message" delete 'including said protected data, and' and insert --includes--

Response to Arguments

- 3. Applicant's arguments see Pre-Appeal Conference Request, filed 5/18/2009, with respect to Claims 1-29 have been fully considered and in combination with arguments

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

The following two pages are Applicants submission of August 25, 2009, labeled "Miscellaneous Incoming Letter" in the image file wrapper. As apparent from this paper is that it is simply correcting Office errors in the Notice of Allowance dated 07-24-2010. Again, according to the clarified Rules, such correction is NOT Applicant delay.

08/05/2009 09:36 FAX 303 778 0748 Kirk D Williams + USPTO Issue Fee 001/002 H2

AUG 5 2009

PATENT Attorney Docket No. 42027

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: John J. WILLIAMS JR ET AL. Group Art Unit: 2165

Application No. 10/811,044 Examiner: HICKS, Michael J

Confirmation No. 9536

Filed: March 27, 2004

For: Bypassing Native Storage Operations
By Communicating Protected Data
Within Locking Messages Using a
Lock Manager Independent of the
Storage Mechanism

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown with sufficient postage as first class and in an envelope addressed to: Mail Stop ISSUE FEE, Commissioner For Patents, PO Box 1450, Alexandria VA 22313-1450, or being transmitted to the USPTO, 771-277-2853 on August 5, 2009.

Kirk D. Williams, Esq.

COMMENTS ON NOTICE OF ALLOWABILITY

Mail Stop ISSUE FEE
Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Allowance and Fee(s) Due mailed July 24, 2009, there are three errors in the Examiner's amendments, as discussed hereinafter. Note, Applicants confirmed that these were in fact errors with Examiner Hicks in a brief telephone conversation on Aug. 5, 2009.

- On page 2, the second paragraph labeled "a)": Instead of "In Line 10 of Claim 1", the amendment should be "In Line 1 of Claim 8".
- On page 2, the paragraph labeled "c)" amending line 1 of Claim 8 should be deleted, as to which no such amendment was agreed, and the amendment doesn't make sense for claim 8. It appears to be a cut & paste typographical error.
- On page 4, the paragraph labeled "p)" should amend line 3, not line 103.

PAGE 1/2 * RCVD AT 8/5/2009 12:38:23 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/8 * DNIS:2732855 * CBID:303 778 0748 * DURATION (min:sec):00:44

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

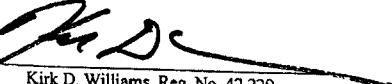
08/05/2009 09:37 FAX 303 778 0748

Kirk D Williams

→ USPTO Issue Fee 002/002

In re John J. WILLIAMS JR ET AL.
Application No. 10/811,044

Applicants believe no fee is due in connection with these comments, however, the
Commissioner is hereby authorized to charge any fee associated with this paper to Deposit
Account No. 501430.

Date: August 5, 2009 By 

Kirk D. Williams, Reg. No. 42,229
One of the Attorneys for Applicants
CUSTOMER NUMBER 26327
The Law Office of Kirk D. Williams
PO Box 39425, Denver, CO 80239-0425
303-282-0151 (telephone), 303-778-0748 (facsimile)

2

PAGE 2/2 * RCVD AT 8/5/2009 12:38:23 PM (Eastern Daylight Time) * SVR:USPTO-EFXRF-4/0 * DNIS:2732885 * CBID:303 778 0748 * DURATION (mm:ss):00:44

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

For completeness, below is the Office's "Miscellaneous Communication to Applicant - No Action Count" (without the mailing cover page) dated 08-27-2009. This paper is simply correcting errors in the Notice of Allowance that were pointed out by Applicants.

M327
MISC Comm to Applicant
ONE PAGE Therof

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO. 10811044	FILING DATE 3/27/2004	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION WILLIAMS ET AL.	ATTORNEY DOCKET NO. 42027
		EXAMINER Michael J. Hicks	
		ART UNIT 2165	PAPER 20090825
DATE MAILED:			

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Please make the following corrections to the NOA dated 7/24/2009:

1. On page 2, the second paragraph labeled "a)": Instead of "In Line 10 of Claim 1", the amendment should be "In Line 1 of Claim 8".
2. On page 2, the paragraph labeled "c)" amending line 1 of Claim 8 should be deleted.
3. On page 4, the paragraph labeled "p)" should amend line 3, not line 103.

/Neveen Abel-Jalil/
Supervisory Patent Examiner, Art Unit 2165

/Michael J Hicks/
Examiner, Art Unit 2165

PTO-90C (Rev.64-03)

In re JOHN J. WILLIAMS, JR. ET AL., US Patent 7,627,573
Request For Reinstatement Of Reduced PTA

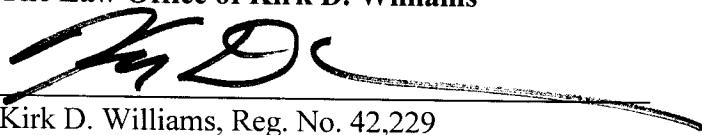
For at least the reasons presented herein, Applicants respectfully request the Office increase the PTA by at least twenty-three days to at least a total of 957 days for US Patent 7,627,573 issued from application 10/811,044.

Applicant believes no additional fees are due with this paper beyond the payment of the fees via EFS-Web, but authorizes the Commissioner to charge any fees due with this communication, or credit any amount being refunded, to Deposit Account No. 501430.

Respectfully submitted,
The Law Office of Kirk D. Williams

Date: May 28, 2010

By



Kirk D. Williams, Reg. No. 42,229
One of the Attorneys for Applicant
The Law Office of Kirk D. Williams
(USPTO Customer Number 26327)
PO Box 61538, Denver, CO 80206-8538
303-282-0151 (telephone), 303-778-0748 (facsimile)